

REMARKS

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Final Office Action of October 12, 2010. Claims 1-5 and 7-23 remain in the application. Reconsideration and/or reexamination of the application is hereby respectfully requested by the applicant.

I. The Office Action

Claims 1, 2, 4, 5, 7, 10-15 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2004/0180689 to Nayak in view of U.S. Pub. No. 2002/0132608 to Shinohara, in view of U.S. Pub. No. 2003/0045273 to Pyhalammi, *et al.* and in further view of U.S. Pub. No. 2004/0103434 to Ellis.

Claims 18, 20 and 23 were rejected under 35 USC § 103(a) as being unpatentable over Nayak in view of Shinohara and Pyhalammi and in further view of U.S. Patent Publication No. 2003/0105825 to Kring, *et al.*

The Examiner rejected to claim 3 under 35 USC § 103(a) as being unpatentable over Nayak in view of Shinohara and Pyhalammi as applied to Claim 1 and further in view of U.S. Patent Publication No. 2004/0207719 to Tervo, *et al.*

The Examiner rejected to claim 8 and 16 under 35 USC § 103(a) as being unpatentable over Nayak in view of Shinohara and Pyhalammi as applied to Claims 1 and 10 and further in view of U.S. Patent Publication No. 2001/0044325 to Cox, *et al.*

The Examiner rejected to claim 21 under 35 USC § 103(a) as being unpatentable over Nayak in view of Shinohara, Pyhalammi and Kring as applied to Claim 18 and further in view of Cox.

The Examiner rejected to claims 9 and 17 under 35 USC § 103(a) as being unpatentable over Nayak in view of Shinohara and Pyhalammi as applied to Claims 1 and 10 and further in view of U.S. Patent No. 7,289,792 to Turunen.

The Examiner rejected to claim 22 under 35 USC § 103(a) as being unpatentable over Nayak in view of Shinohara, Pyhalammi and Kring as applied to Claim 18 and further in view of Turunen.

II. The Combination of Nayak, Shinohara, Pyhalammi, et al. and Ellis Fails to Render Claims 1-2, 4-5, 7, 10-15 and 19 Obvious

Claims 1-2, 4-5, 7, 10-15 and 19 were rejected as being unpatentable over Nayak, in view of Shinohara and Pyhalammi, and further in view of Ellis. It is respectfully requested that this rejection be withdrawn for at least the following reason. It is not obvious to combine Nayak with Shinohara, Pyhalammi and Ellis.

Generally, the subject application relates to mobile-to-mobile video capability on a network. A delivery preference for a user of a mobile station can be determined. In particular, independent claim 1 recites a mobile switching center comprising the claimed modules. Independent claim 10 recites a similar feature.

The Examiner relies on Nayak to disclose a mobile switching center comprising a call recognition module operative to recognize a call from the first mobile station to the second mobile station as including the video data and, if the video data is present, validate the second mobile station as capable of receiving the video data. The Examiner concedes that the cited portion of Nayak fails to disclose a determining a delivery preference for the second mobile station based at least in part on information retrieved from at least one database, wherein a subscriber sets the delivery preference by selecting immediate delivery, delayed delivery, blocked delivery, or conditional delivery.

The mobile switching center of Nayak may disclose determining whether a called party can accept a video call. However, determining whether a party can accept a video call is different than determining a delivery preference, storing the video data in the storage module upon recognition, receiving the response from the announcement module and, based on at least one of the delivery preference and the response. The functions of Nayak also differ from performing at least one of maintaining the video data in the storage module, deleting the video data from the storage module, and forwarding the video data to the second mobile station. It is submitted that the mobile switching center disclosed in Nayak is inoperative to perform the claimed functions, or to incorporate the claimed modules. It is submitted that a person having ordinary skill in the art would not combine the cited references to render the claims obvious.

Nayak relates to a system that addresses a problem with mobile phones having different functionality. Nayak states that when phones of different generations do not have the same functionality (e.g., when one mobile phone has video capability but another mobile phone does not have video capability) but still try to communicate, calls are typically lost.

In Nayak, a technique is disclosed whereby the system first determines whether two mobile phones seeking to communicate have the same functionality (e.g., video capability). If not, the system of Nayak does not drop the call but instead establishes a communication session in which both phones can participate (e.g., a voice call). The video data is sent elsewhere in this case.

It is submitted that the Examiner is relying on hindsight bias to disclose the claimed subject matter. Accordingly, since the focus of Nayak is on addressing the problem of incompatible phones, where one phone is unable to receive video, one of skill in the art would not look to any of Shinohara, Pyhalammi or Ellis (let alone all of them) to modify Nayak to add functionality on allowing for user preferences for delivery when phones are compatible. Nayak seeks to solve a network problem, not provide more choices to users. Thus, it is submitted that the suggested combination of Nayak, Shinohara, Pyhalammi and Ellis would not be made and would not render the claims obvious.

Further, even if some of the suggested functionality could somehow be combined, the resultant system would not necessarily have all functionality within a mobile switching center, as claimed. The Examiner has not fairly established how this could be accomplished.

Accordingly, it is respectfully requested that this rejection be withdrawn with respect to independent claims 1 and 10 (and associated dependent claims 2, 4-5, 7, 11-15 and 19).

III. The Combination of Nayak, Shinohara, Pyhalammi, et al. and Kring Fails to Render Claims 18, 20 and 23 Obvious

Claims 18, 20 and 23 were rejected as being unpatentable over Nayak, in view of Shinohara and Pyhalammi, and further in view of Kring. It is respectfully requested that

this rejection be withdrawn for at least the following reason. It is not obvious to combine Nayak with Shinohara, Pyhalammi and Kring.

Independent claim 18 recites a mobile switching center comprising claimed means. Claims 20 and 23 depend from independent claim 18. As noted *supra*, the cited portions of Shinohara and Pyhalammi *et al.* fail to disclose or suggest a mobile switching center. Kring *et al.* appears to disclose a mobile switching center (MSC), but similarly to Nayak, Kring *et al.* does not disclose or suggest that the MSC can be modified to incorporate the claimed modules, or equivalent functions of the claimed modules. It is submitted that a person having ordinary skill in the art would not combine the cited references and produce an operative device. Thus, similar to above, it is submitted that the combination of Nayak, Shinohara, Pyhalammi and Kring is not obvious.

Further, even if some of the suggested functionality could somehow be combined, the resultant system would not necessarily have all functionality within a mobile switching center, as claimed. The Examiner has not fairly established how this could be accomplished.

Accordingly, it is respectfully requested that this rejection be withdrawn with respect to independent claim 18, and associated dependent claims 20 and 23.

IV. Rejection of Claim 3 Under 35 U.S.C. § 103(a)

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nayak, and Shinohara in view of Pyhalammi *et al.*, and further in view of Tervo *et al.* It is respectfully requested that this rejection be withdrawn for at least the following reasons. Claim 3 depends from independent claim 1, and the cited portions of Tervo *et al.* fail to make up for the aforementioned deficiencies of Nayak, Shinohara and Pyhalammi *et al.* with respect to independent claim 1. Accordingly, this rejection should be withdrawn.

V. Rejection of Claims 8 and 16 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 8 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Nayak, and Shinohara in view of Pyhalammi *et al.*, and further in

view of Cox *et al.* It is respectfully requested that this rejection be withdrawn for at least the following reasons. Claims 8 and 16 are dependent from independent claims 1 and 10, respectively. The cited portions of Cox *et al.* fail to remedy the aforementioned deficiencies of Nayak, Shinohara and Pyhalammi *et al.* with respect to independent claims 1 and 10. Thus, it is submitted that this rejection should be withdrawn.

VI. Rejection of Claim 21 Under 35 U.S.C. § 103(a)

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nayak, and Shinohara in view of Pyhalammi *et al.*, and further in view of Kring *et al.* and Cox *et al.* It is respectfully requested that this rejection be withdrawn for at least the following reasons. Claim 21 depends from independent claim 18. Cox *et al.* fails to make up for the aforementioned deficiencies of the remaining references. Accordingly, this rejection should be withdrawn.

VII. Rejection of Claims 9 and 17 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Nayak, and Shinohara in view Pyhalammi *et al.*, and further in view of Turunen. It is respectfully requested that this rejection be withdrawn for at least the following reasons. Claims 9 and 17 depend from independent claims 1 and 10, respectively, and the cited portions of Turunen fail to remedy the above-mentioned deficiencies of Nayak, Shinohara and Pyhalammi *et al.* with respect to independent claims 1 and 10. Thus, it is submitted that this rejection should be withdrawn.

VIII. Rejection of Claim 22 Under 35 U.S.C. § 103(a)

The Examiner rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Nayak, and Shinohara in view Pyhalammi *et al.*, and further in view of Turunen and Kring *et al.* It is respectfully requested that this rejection be withdrawn for at least the following reasons. Claim 22 depends from independent claim 18. The cited passages of Kring *et al.* fail to cure the above-mentioned deficiencies of the remaining portions of the references with respect to the subject claims. Accordingly, it is respectfully requested that this rejection be withdrawn with respect to claim 22.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-5 and 7-23) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

☒ Remaining Claims, as delineated below:

(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT LESS HIGHEST NUMBER PREVIOUSLY PAID FOR		(3) NUMBER EXTRA
TOTAL CLAIMS	22	- 25 =	0
INDEPENDENT CLAIMS	3	- 3 =	0

☒ This is an authorization under 37 CFR 1.136(a)(3) to treat any concurrent or future reply, requiring a petition for extension of time, as incorporating a petition for the appropriate extension of time.

☒ The Commissioner is hereby authorized to charge any filing or prosecution fees which may be required, under 37 CFR 1.16, 1.17, and 1.21 (but not 1.18), or to credit any overpayment, to Deposit Account Number 06-0308.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to telephone Joseph D. Dreher, at 216.363.9000.


Respectfully submitted,

Fay Sharpe LLP

December 13, 2010

Date


Joseph D. Dreher, Reg. No. 37,123
The Halle Building, 5th Floor
1228 Euclid Avenue
Cleveland, Ohio 44115-1843
216.363.9000

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Date: December 13, 2010	Name: Roseanne Giuliani